

Remarks

Applicant respectfully requests reconsideration and allowance of the present application in view of the claim amendments and remarks below.

Claims 1-8 and 10-12 stand rejected under 35 U.S.C. §102(e) as being unpatentable over US Patent Application No. 2003/0050109 (Caro et al.). Claims 9 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent Application No. 2004/0266514 (Penrice).

In the present response, Applicant has amended independent claims 1, 14, and 18 to more clearly recite embodiments within the scope of the present invention. Specifically, Applicant has amended independent claims 1, 14, and 18 to recite the “outcome of the instant win game being independent from the base wagering game entry.” The specification describes and enables this limitation in paragraphs [0078] – [0086] and in figures 8 and 9. As described therein, a player selects a base wagering game entry for the base wagering game. The player can then also elect to play an instant win game, and the outcome of the instant win game is completely independent of the base wagering game entry. For example, as shown in Figures 8 and 9, the player selects Keno numbers 02, 11, 44, 59, and 69 as the base wagering game entry. The player further elects to play an instant win game by marking the YES box (378) in Figure 8. As shown in Figure 9 and described in paragraphs [0085]-[0086], the base wagering game entry is not used in determining the outcome of the instant win game. Thus the outcome of the instant win game is independent of the base wagering game entry.

Based on the present amendments to independent claims 1, 14, and 18, Applicant respectfully traverses the rejection under U.S.C. §102(e) for at least the reason that Caro et al. does not disclose or teach that the outcome of the instant win game is independent from the base wagering game entry. Specifically, Caro et al. teaches a wagering game and an instant win game. However, Caro et al. specifically describes that the instant win game uses the wagering game entries from the wagering game (See Caro et al., paragraph [0053] - “the same player-selected number set 26 is used to participate in a second game, the future draw game.”). Therefore, the outcome of the instant win game taught by Caro et al. is not independent of the base wagering entry as recited in independent claims 1, 14, and 18. For at least this reason, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(e) rejection of claims 1-8 and 10-12.

Applicant also traverses the rejection under U.S.C. §102(e) for at least the reason that Caro et al. does not disclose or teach a “game theme” as recited in independent claim 1. Specifically, independent claim 1 recites (1) storing a game theme indicator, (2) storing a plurality of instant win game outcome display themes, and (3) displaying the outcome of the instant win game with one of the plurality of instant win game outcome display themes. As described on paragraph [0075],

The instant win game may be an additional lottery game wherein multiple themes are available for displaying the outcome of the lottery game while using the same logic for determining the outcome of the lottery game.

Paragraph [0088] further describes that “the instant win game may be displayed to the user in print or video form with one of a plurality of available themes, such as blackjack,

poker, Bingo, football and the like.” Figures 9-11 illustrate examples of these game themes.

In contrast to the “game theme” limitations recited in independent claim 1, the game taught by Caro et al. simply displays the player selected numbers (i.e., the base wagering game entries) and the winning set of numbers for the instant win game (See figures 2-10). Paragraph [0041] of Caro et al. describes various methods for determining the outcome of the base wagering game, such as drawing identical numbered balls, the occurrence of some public events, or the score of a sports event as. However, none of these methods for determining the outcome of the base wagering game are known or determined at the time of the instant win game. Therefore, Applicant respectfully asserts that Caro et al. fails to disclose or teach (1) storing a game theme indicator, (2) storing a plurality of instant win game outcome display themes, and (3) displaying the outcome of the instant win game with one of the plurality of instant win game outcome display themes. For at least this reason, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(e) rejection of claims 1-8 and 10-12.

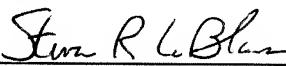
Regarding the 35 U.S.C. §103(a) rejection of claims 9 and 13-20, Applicant respectfully submits that the present application and the Penrice application were, at the time the present invention was made, both obligated to assignment to the company Scientific Games Royalty Corporation. Therefore, pursuant to 35 U.S.C. Section 103(c)(1), Penrice cannot preclude patentability under 35 U.S.C. Section 103, and

Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claims 9 and 13-20.

For at least the reasons discussed above, Applicant respectfully submits that the claims patentably define over the cited references. As such, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Should any issues remain after consideration of this amendment, then Examiner Pandya is invited and encouraged to telephone the undersigned. If any fee not accounted for above is required for entry of this Amendment or papers filed herewith, authorization is hereby granted to charge such fee to Deposit Account No. 04-1403. If any petition is required for entry, such petition is hereby made and any associated fees may also be charged to our deposit account.

Respectfully submitted,

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